

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE MATTER OF:

Robert SKVORECZ

SERIAL NO.: 09/772,278

FILED: March 15, 2001

FOR: WIRE CHAFING STAND

GROUP: 3632

EXAMINER: LE, TAN

OFFICIAL

FAX RECEIVED

JUN 28 2002

GROUP 3600

RESPONSE

Assistant Commissioner of Patents  
& Trademarks  
Washington, DC 20231

S I R:

Applicant respectfully requests that the period for response to the outstanding office communication dated December 14, 2001 be extended for one month until April 14, 2002. The fee for granting this request should be deducted from our Deposit Account No. 01-1944.

The Reissue Oath/Declaration filed with the application has been alleged to be defective in paragraphs 6, 8 and 9 of the office communication. Applicant respectfully requests that the request for a supplemental Reissue Oath/Declaration under 37 CFR 1.175(b)(1) be held in abeyance until an indication is received of the allowability of the Reissue application. The new supplemental Reissue Oath/Declaration will include the post office address of the inventor and will include a statement that "All errors being corrected in the Reissue application up to the time of the filing of the Oath/Declaration

NYDOCS1-627075.1

7.29.02  
Req Ext of Time

Approved

Clerk

*One Time Only*  
*Adriana Lewis*

#5/req for  
extension  
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+ ptd  
response  
7.29.02

arose without any deceptive intent on the part of the applicant" and will further include the statement that "Every error in the patent which was corrected in the present Reissue application, and is not covered by a prior Oath/Declaration submitted in this application, arose without any deceptive intent on the part of the applicant". In addition, claim 7, which is new, will be fully underlined as requested by the Examiner in a telephone interview on April 9, 2002.

The subject Reissue application has been filed to enlarge the scope of claim 1 as issued in U.S. Patent No. 5,996,948 and was filed within two years of the issue date of the patent under 35 USC 251 and 37 CFR 1.172. This is clearly set forth in the Reissue Petition and in the Oath/Declaration. The error of applicant in claiming less than he had a right to claim, did not surface until after the patent issued and following a discussion between applicant and the undersigned attorney resulting in the filing of the Reissue application.

The error in claim 1 of the issued patent resides in the unnecessary inclusion of the lower rim element of the wire chafing stand. The lower rim is not related to the invention and was acknowledged as being known in the prior art. The lower rim was also used in the claim as a point of reference to designate a relative location for the structural components of the stand which are essential to the invention.

The rejection of claims 1-5 and 7 under 35 USC 251 as an attempt to recapture claimed subject matter surrendered in the issued patent upon which the present Reissue application is based is respectfully traversed.

The Examiner has compared claim 1 in the Reissue application to claim 1 as issued in U.S. Patent 5,996,948 and has pointed out that the language describing the existence of a lower rim was present in the issued claim 1 and was part of the language referred to in the amendment filed on July 26, 1999 (paper no. 3) and part of amendment to the independent claim 1 which was allowed based on the amendment. Based upon

this, the Examiner concluded that the removal of the lower rim from the Reissue claim language amounts to recapture.

Applicant believes that the Examiner's comparison of the language in the issued claim and the underlining of selected words in claim 1 gives misplaced emphasis to words which were never involved in the prosecution and have no relevance to the allowance. This becomes clear upon review of the prosecution of the issued patent and the reasons set forth in the Notice of Allowance.

Looking back at the prosecution of the issued parent patent application serial number 09/005,787, a first office action was issued on April 23, 1999 rejecting the claims under 35 USC 102 as being anticipated by U.S. Patent No. 1,688,846 to Andrews. The Examiner stated that "Andrews" discloses a wire stand (Fig. 1) comprising an upper rim of wire steel (10) which forms a closed geometrical configuration circumscribing a first surface area, a lower rim (16) of wire steel forming a closed geometrical configuration circumscribing a second surface area with the first surface area being larger than the second surface area, etc. Accordingly, the use of a lower rim and its relationship relative to the upper rim was known in the prior art. Applicant at no time argued that the lower rim was novel or was not shown in Andrews. To the contrary, this fact was never an issue and was not a feature of the claim for distinguishing over the prior art.

Applicant filed an amendment dated July 12, 1999 in response to the first official action to clearly distinguish the invention from the teaching in Andrews '846. To do so, it was necessary to amend the claim since the rejection was under 35 USC 102 and not under 35 USC 103. It was essential to introduce a novel feature into claim 1 not already shown in "Andrews". It was also necessary to include wording relative to the novel feature which would also make the amended claim 1 patentable under 35 USC 103.

Applicant first explained to the Examiner that the subject invention relates to the problem of the cost involved in the transportation of the wire stand. To solve this problem, it was necessary for one wire stand to be able to be readily nested into other

wire stands to form a nested multiplicity of stands without significant wedging. Nested stands do not take up much additional space when being transported over that of a single stand. Applicant then explained that it is the construction of the wire legs and offsets in the stand that facilitates nesting of stands. The wire legs are constructed with each wire leg having two upright sections interconnected to one another in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from the base support to form an angle equal to or greater than 90° with respect to a horizontal plane through the base support and further comprising a plurality of offsets located either in the upright sections or in the upper rim. This constitutes the novel feature of the invention differentiating it from the prior art "Andrews" both under 35 USC 102 and 35 USC 103. Note that the lower rim element is not functionally involved.

To satisfy the requirements of 35 USC 112, a claim cannot merely just identify a novel feature but must also relate the feature to the other elements so as to define a structure. Some reference must be made to locate the new features to the other features. It is for this reason that the wire legs were defined in claim 1 placing them at a location relative "to something". Unnecessarily, the lower rim was used as the "locating" point of reference to satisfy this requirement.

As regards the amendment of applicant, applicant argued in the Amendment that "Andrews does not teach wire legs having a construction with upright sections interconnected to form a base support. Instead, a separate base ring is used in Andrews." Applicant also pointed out that each upright section of the wire chafing stand in amended claim 1 extends upwardly from the base support at an angle equal to or greater than 90° with respect to a horizontal plane extending through the base. As explained in the argument, this arrangement is clearly not taught in Andrews and is extremely important to facilitate nesting. Furthermore, the argument points out that this feature alone is novel but does not overcome the secondary problem of wedging. This secondary problem is overcome by the use of a plurality of offsets located either in the upright sections of the wire legs or in the upper rim. Note, no mention is made of the

lower rim and no significance was attributed to the relative location of the wire legs and offsets to that of the lower rim. It was further pointed out that claim 1 does not use the word "offset" independent of its function which is to facilitate nesting.

In response to the amendment filed by applicant on July 12, 1999, the Examiner issued a "Notice of Allowance" which contained a paragraph entitled "Reasons For Allowance". The Reasons For Allowance paraphrased almost all of the language of claim 1. However, the Examiner placed emphasis on the claimed feature of a "plurality of offsets located either in the upright sections of the wire legs or in the upper rim, for laterally displacing each wire leg relative to the upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging." This was a key feature which alone distinguishes over Andrews. Again no mention or statement is made of any contribution by the lower rim element to this function or of any contribution due to the relative location of the legs to the lower rim.

Now, however, the Examiner, in paragraph 10 of the office action, underlines wording in the claim and gives such wording a misplaced emphasis which is not supported by the file history. Instead, the Examiner is now reading and comparing the claims "in a vacuum" independent of the file history and almost as if the file of the parent case was not available to the Examiner. This is not the test for recapture as set forth in chapter XIV of the MPEP. Moreover, the Examiner is now reconsidering the novelty of the lower rim to give new significance to words never before considered relevant by the Examiner in the allowance. Furthermore, recapture cannot apply to a feature which is not novel and acknowledged as such both by the Examiner and applicant.